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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09:936,951	12/10/2001	Bernard Robert	704-010563-US(PAR)	4437

2512 7590 09/16/2003

PERMAN & GREEN  
425 POST ROAD  
FAIRFIELD, CT 06824

EXAMINER
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KNAUSS, SCOTT A

ART UNIT	PAPER NUMBER
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2874

DATE MAILED: 09/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/936,951

Applicant(s)

ROBERT ET AL.

Examiner

Scott A Knauss

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 8/11/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-20,23 and 29-32 is/are allowed.
- 6) ☒ Claim(s) 16,21,22,24-28 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. The amendment filed 8/11/03 has been entered and carefully considered by the examiner. In response, the previous rejection has been withdrawn, and the following new rejection is applied.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 33,16,21,22, and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,367,593 (Lebby et al).

Regarding claim 33, Lebby discloses an optoelectronic connector in fig. 3 comprising:

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A package #27;

An optical port #32;

An electrical port #40

An optoelectronic circuit positioned in the package and connected to both ports, which includes emission (lasers, light emitting diodes, etc.) and detection (photodetectors, photodiodes) circuit chips #45 (see column 5, lines 20-24), and also IC chip #150

An internal wall of the package being provided with metallized connections (see fig. 4, pads of the integrated circuit being connected directly to the metallized connections (see column 3, lines 29-31)

Furthermore, the device of Lebby can be considered a "base unit link" since it is used to connect a light transmitter or receiver to a fiber optic cable (see figs. 1,2)

Lebby does not, however, explicitly disclose a "bare control" chip. Nevertheless, Lebby does disclose the use of IC chip #50, and discloses that emission-detection elements #45 may be connected directly to the IC chip and even be formed directly on the IC chip (see column 4, lines 40-43).

Although Lebby does not explicitly specify using the IC chip to *control* the emission-detection elements, such an arrangement is well known in the art, for example, to amplify optical signals received using amplifier circuitry on an IC chip, and to drive optical transmitting elements via the IC chip

Therefore it would have been obvious to one of ordinary skill in the art to modify the optoelectronic connector of Lebby to use amplifier or driver circuitry on the IC chip

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#50 in order to drive optical transmitters or amplify optical signals received via the IC chip, and thus control the emission detection elements. Furthermore, since the IC chip of Lebby is not placed in a package of its own, the examiner considers it to be a "bare" control circuit.

Regarding the limitations "the laser diodes being formed in a predetermined arrangement from a gallium arsenide substrate and deposited on the integrated circuit chip by transfer from an intermediate support that maintains the predetermined arrangement", the examiner submits that the applicant is claiming the product including the process of making an optoelectronic package, and therefore the claim is of a "*product-by-process*" nature. The courts have been holding for quite some time that: the determination of the patentability of product-process claim is based on the product itself rather than on the process by which the product is made. In re Thrope, 777 F. 2d 695, 227 USPQ 964 (Fed. Cir. 1985); and patentability of a claim to a product does not rest merely on a difference in the method by which that product is made. Rather, it is the product itself which must be new and unobvious. Applicant has chosen to claim the invention in the product form. Thus, a prior art product which possesses the claimed product characteristics can anticipate or render obvious the claimed subject matter regardless of the manner in which it is fabricated. A rejection based on 35 U.S.C. section 102 or alternatively on 35 U.S.C. section 103 of the status is eminently fair and acceptable. In re Brown and Saffer, 173 USPQ 685 and 688; In re Pilkington, 162 USPQ 147.

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Thus, no weight is given to the process steps recited in claim 33, and the device of Lebby, as modified, fully meets the limitations set forth in the product portion of the claim.

Regarding claim 16, in order to couple light between laser diode and optical fiber terminations #47, the spacing between the diodes would inherently need to be the same as the spacing between the fibers.

Regarding claim 21, as stated above, Lebby discloses pads of the integrated circuit being connected directly to the metallized connections (see column 3, lines 29-32)

Regarding claim 22, Lebby discloses the use of vertical cavity surface emitting lasers (VCSEL's), (see column 3, lines 7-8) but does not disclose whether GaAs VCSEL diodes are used.

Nevertheless, VCSEL diodes formed from GaAs are known in the art, and it would have been obvious to one of ordinary skill in the art to substitute known VCSEL diodes into the device disclosed by Lebby for the purpose of emitting light into optical fibers.

Regarding claim 24, Lebby discloses an optical port having a part (hole #35) for positioning optical fiber terminations #47, this part abutting what can be considered a "cant" (edge #34).

Regarding claim 25, Lebby does not disclose the connector being limited access with two optical channels or the electrical port having contacts for electrical signals and contacts for a ground signal.

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Nevertheless, connectors having only two optical channels are known in the art in order to provide a transmitter/receiver function, and it is well known in the art to provide integrated circuits with both electrical and ground signals to connect to external circuitry, and thus it would have been obvious to one of ordinary skill in the art to modify the connector as set forth in claim 1 to have only two optical channels and to provide ground and electrical signals to the integrated circuit, in order to provide a connector having a transmitter and receiver function, and to electrically connect the integrated circuit to external circuitry.

Regarding claim 26, the flat rectangular shape of the connector of Lebby would enable it to be stacked on another such connector.

Regarding claim 27, Lebby discloses that photonic elements, including laser diodes, may be mounted directly to the integrated circuit (see column 3, lines 6-10, column 4, lines 47-49), but does not disclose how the photonic elements are connected to the integrated circuit, in particular, whether pads of the laser diodes are connected by connection wires directly to pads of the integrated circuit. Nevertheless, such connection methods are known in the art, and it would have been obvious to one of ordinary skill in the art to use known connection means to connect the photonic elements to the integrated circuit.

Regarding claim 28, Lebby discloses the use of light receiving and light emitting elements (column 3, lines 6-10) which carry out a conversion of signals available at the optical port into signals available at the electrical port, and vice versa.

***Allowable Subject Matter***

5. Claims 17 and 23, previously indicated as containing allowable subject matter, have been rewritten in independent form and to correct various informalities and are allowed, as are dependent claims 18-20.

Claim 29, previously indicated as containing allowable subject matter has also been amended to correct informalities, and is also allowed, as are dependent claims 30-32.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott A Knauss whose telephone number is (703) 305-5043. The examiner can normally be reached on 9-5 Monday-Friday.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on (703) 308 - 4819. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0530.

Scott Knauss

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sak

  
HEMANG SANGHAVI  
PRIMARY EXAMINER